

Remarks

Claims 1-5 are currently active in the application. Claims 1-2 stand rejected under 35 U.S.C. §103(a) as obvious over Nicholson '769. Claims 3, 4, and 5 stand objected to as depending from a rejected base claim.

Claim Rejections --- 35 U.S.C. §103(a)

Claims 1 and 2 stand rejected under 35 U.S.C. §103(a) as obvious over Nicholson '769.

Nicholson '769 teaches an implant for spinal fusion. Nicholson '769 teaches, in multiple locations in the specification, that the device needs bone growth material to bond with the adjacent vertebrae. See, e.g., Nicholson '769 col. 5, lines 38-42; col 6, lines 53-58, etc. Nicholson '769 neither teaches, discloses nor suggests using the implant for vertebral fusion without a bone graft. Nicholson effectively teaches away from any method of fusing adjacent vertebrae without a bone graft. Further, Nicholson '769 makes no mention of applying bioactive coatings to the implant.

Claim 1 requires a process for fusing spinal vertebrae that:

- (1) employs an implant with a bioactive coating on its surfaces and protruding members; and
- (2) achieves fusion without using a bone graft.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. See MPEP 2143.03. Nicholson provides no teaching or suggestion of either of these two limitations

of claim 1. As such, a prima facie case of obviousness has not been made. Applicant respectfully traverses the assertion made in the office action on page 3, ¶ 5. that:

"The issue centers around the claim language of 'fusion of the vertebrae is achieved without a bone graft.' The examiner upon much deliberation considers this limitation to be analogous to the limitation of an element being 'capable of performing the cited limitation.'

The issue is not whether Nicholson's implant could have a bioactive coating applied to it and then be used without bone graft material, but, rather, whether Nicholson fairly teaches or suggests such a method of achieving spinal fusion. Nicholson '769 does not teach or suggest such a method and, therefore, rejection of claim 1 as obvious over Nicholson '769 must involve impermissible hindsight reconstruction gleaned from the disclosure of the instant application.

See MPEP 2145.

Since a prima facie case of obviousness over Nicholson '769 has not been made, claim 1 is allowable over Nicholson '769.

Claim 2, which depends from claim 1 and adds further limitations, is allowable over Nicholson '769 for at least the same reasons as for claim 1.

Claim Objection

Claims 3-5 stand objected to as depending from a base claim that is not allowable. As argued above, Applicant believes the base claim as written is allowable. Thus, claims 3-5, which depend from claim 1 and add further limitations, are allowable as written.

For the reasons set forth above, it is submitted that all pending claims are now in condition for allowance. Reconsideration of all pending claims and a notice of allowance are therefore requested. If any additional fees are required for the timely consideration of this application, please charge deposit account number 19-4972. The Examiner is requested to telephone the undersigned if any matters remain outstanding so that they may be resolved expeditiously.

Respectfully submitted,



John L. Conway
Registration No. 48,241
Attorney for Applicant

Bromberg & Sunstein LLP
125 Summer Street
Boston, MA 02110-1618
(617) 443-9292

02731/00103 359237